Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)
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U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

PRE-APPEAL BRIEF REQUEST FOR REVIEW	Docket Number (Optional) 0905-0255P	
	Application Number 09/764,062-Conf. #6672	Filed January 19, 2001
	First Named Inventor Takeshi MISAWA	
	Art Unit 2612	Examiner J. P. Misleh

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- [ ] applicant /inventor.
- [ ] assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- [ ] attorney or agent of record. Registration number _____
- [x] attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. 40,439

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June 8, 2006
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

- [ ] *Total of 1 forms are submitted.

REASONS IN SUPPORT OF THE REQUEST FOR

PRE-APPEAL BRIEF REVIEW

In paragraph 5 of the final Office Action ("Action"), the Examiner rejects claims 1-3, 5, 8, and 10-15 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,211,911 to Komiya et la. ("Komiya") in view of U.S. Patent No. 4,602,289 to Sekine ("Sekine"). The Examiner's rejection of claims 1-3, 5, 8, and 10-15 as being unpatentable over the combination of Komiya and Sekine is improper because the Examiner failed to establish a *prima facie* case of obviousness as discussed below.

Independent claim 1 defines an image sensing device. The device includes, *inter alia,* an image sensing unit that includes a honeycomb-type solid-state electronic image sensor, a first recording controller that records image data output from the image sensing unit, and a second recording controller *that records data that represents characteristics based on a structure of lens of the honeycomb-type solid-state image sensor.* The honeycomb-type solid-state image sensor has a number of photoelectric transducers disposed in column and row directions, wherein the photoelectric transducers for odd-numbered columns are placed in odd or even numbered rows and the photoelectric transducers for even-numbered columns are placed in even or odd numbered rows.

In rejecting claim 1, the Examiner asserts that Komiya discloses an image sensing device which includes a first and second recording controller as claimed inasmuch as Komiya discloses an image processing unit that sends the setting values for the photographing conditions, such as the focal length, lens position, shutter speed of the CCD, white balance, compression mode, and the like, to a data writing section. These setting values are combined with the compressed image data as header information and written in a memory card 23.

Although Komiya discloses recording characteristics, such as focal length, associated with the photographing lens (i.e., element 15 of Fig. 3A) which are arguably characteristic of the structure of the photographing lens 15, if the Examiner reviews the cited passage (i.e., column 5, lines 54-67), he will see that these characteristics relate to the photographing conditions of the photographing lens system, not of the CCD 17. In fact, the only characteristic disclosed in Komiya that relates to the CCD 17 is shutter speed. Therefore, even if one skilled in the art were motivated to replace the CCD 17 of Komiya with a honeycomb-type image pick-up sensor as suggest by the Examiner, the resultant combination would still fail to disclose or suggest recording data that represents characteristics based on a structure of lenses of *the honeycomb-type solid-state electronic image sensor* as claimed.

In response the Examiner asserts that claim 1 requires "a structure of lenses of the honeycomb-type solid-state electronic sensor," not the "structure of on-chip lenses or inner lenses of the honeycomb-type solid-state electronic image sensor." Accordingly, it appears that the Examiner is asserting photographing lens 15 of Komiya is a part of the CCD 17. Applicant respectfully disagrees.

One skilled in the art would readily appreciate that the *structure of lenses of the honeycomb-type solid-state electronic image sensor* as recited in claim 1 corresponds to the structure of on-chip lenses or inner lenses of the honeycomb-type solid-state electronic image sensor, and not any lens within a photographic device as asserted by the Examiner. Fig. 3A of Komiya clearly illustrates the photographing or zoom lens 15 as a separate element from the CCD 17. Nowhere in Komiya is there any disclosure or suggestion of record characteristics associated with the lens *of the* CCD. Accordingly, claim 1 is patentable over the combination of

Komiya and Sekine for at least the reason that the combination fails to disclose or suggest each and every claimed element.

In addition, the Examiner notes that Komiya fails to disclose that the image sensing unit includes a honeycomb-type solid-state electronic image sensor as claimed. However, the Examiner relies on Sekine as disclosing that honeycomb image sensors are "notoriously well known in the art." Therefore, the Examiner asserts that it would have been obvious for one skilled in the art "to have included a honeycomb image sensor, as taught by Sekine, in the image sensing apparatus and corresponding method of operating thereof, disclosed by Komiya et al., for the advantage of improving vertical resolutions." Theses assertion is unfounded for the following reasons.

First, as discussed in § 2143.01 of the MPEP, the mere fact all the elements of a claimed invention may have been individually known in the art is not sufficient in and of itself to establish a *prima facie* case of obviousness, absent some objective reason to combine the individual teachings. Furthermore, the mere fact that a reference can be combined does not render the resultant combination obviousness unless the prior art also discloses the desirability of the combination. In this regard, the Examiner asserts that one skilled in the art would have been motivated to replace the semiconductor image pickup element 60 of Komiya with a honeycomb image sensor as disclosed by Sekine in order to achieve the advantage of improving vertical resolutions. To support this assertion, the Examiner points to column 2, lines 34-37 of Sekine.

Although the cited passage, i.e., column 2, lines 34-37 of Sekine discloses that an object of Sekine's invention is to provide a solid-state image pick-up device in which horizontal and vertical pixel packing densities are improved and vertical resolution is also improved, one skilled in the art would appreciate that these improvements are over prior art honeycomb-type image

pick-up devices as shown in Figs. 1A –1C of Sekine, not all image pick-up devices. Nowhere in Sekine is there any disclosure or suggestion that the Sekine's honeycomb-type image pick-up device would improve vertical resolution over the semiconductor image pickup device of Komiya. Furthermore, nowhere in Komiya is there any disclosure or suggestion that the vertical resolution of Komiya image sensing device needs improvement.

In response, the Examiner asserts that "[a]ll image sensors would benefit from the 'improving vertical resolutions.'" However, neither the Examiner nor the cite art provides any evidence that the reduced pixel pitch disclosed in Sekine is applicable to *all* image sensors. Accordingly, absent some evidence that *all* image sensors would or could benefit from the reduced pixel pitch as disclosed in Sekine the rejection is improper.

Independent claim 3 defines a method of controlling operation of an image sensing device. The method includes, *inter alia*, recording data that represents characteristics based on a structure of lenses of the honeycomb-type solid state electronic image sensor on a recording medium in association with the image data. Therefore, claim 3 is patentable over the combination of Komiya and Sekine because (1) the Examiner fails to provide proper motivation to combine Komiya and Sekine or (2) the combination fails to disclose recording data that represents characteristics based on a structure of lenses of the honeycomb-type solid state electronic image sensor. (See discussion above with respect to claim 1.)

Claims 2, 5, 8, and 10-15 variously depend from independent claims 1 and 3. Therefore, claims 2, 5, 8, and 10-15 are patentable over the combination of Komiya and Sekine for at least those reasons presented above with respect to claims 1 and 3. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 1-3, 5, 8, and 10-15 under 35 U.S.C. § 103(a).